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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,442	11/22/2005	Mark Godden	4758-4101US1	4270
27123	7590	07/02/2007		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER HESS, BRUCE H	
			ART UNIT	PAPER NUMBER
			1774	
			MAIL DATE	DELIVERY MODE
			07/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,442	Applicant(s) GODDEN ET AL.	
	Examiner Bruce H. Hess	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-30-07 (election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 8-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 24-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-18-05</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1774

In view of the fact that the present case is a 371 application, the prior restriction requirement is clarified and replaced by the following Lack of Unity requirement.

Restriction is required under USC 121 and 372.

This application contains the following inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicants are required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-7 and 24-33 drawn to articles.

Group II, claims 8-17 drawn to methods of making articles.

Group III, claims 18-23 drawn to systems for making articles.

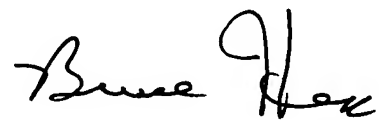
The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding features for the following reasons: Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a special technical relationship among those inventions involving one or more of the same corresponding technical features which define a contribution over the prior art. See 37 CFR 1.475. The special technical feature of the present invention - a donor web having information indicia ink-jetted onto thermal transfer material - does not define a contribution over the prior art, as is revealed by either of Japanese Patents 63-278889 or 02-20379 in view of any of US Patents 5,501,902, 5,798,179, or 6,582,803 (see the following action for a detailed discussion of the teachings of these patents). Consequently, a lack of unity exists. See 37 CFR 1.475 and MPEP §1850.

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In view of the fact that applicants have already elected the invention of claims 1-7 and 24-33, these claims will be given an action on the merits in this application.

2. Claims 1-7 and 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Morikawa (JP 63-278889) or Kanzaki et al. (JP 02-20379) in view of any of Kronzer '902 (USP 5,501,902), Kronzer '179 (USP 5,798,179) or Cole et al. (USP 6,582,803).

The primary references teach thermal donor webs having a substrate, a layer of transferable thermal material and detection marks for determining the location of the printing material on the webs. The secondary references teach that ink jet indicia are conventionally applied to thermal donor webs. Use of the secondary references' ink jet indicia as the generically disclose indicia of the primary references would have been obvious to one of ordinary skill in this art in the absence of unexpected results. The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine the location of the detection marks) fails to render applicants' claims patentable in the absence of unexpected results.



BRUCE H. HESS
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